

### REMARKS

Claims 1-5, 11, 13, and 14 are pending in this application, claims 6-10 and 12 having been withdrawn in this amendment. The amendments to claims 1, 3, and 5 are supported in the specification at, for example, page 6, lines 6-10, page 7, lines 7-9, and page 8, line 18, to page 9, line 12. The amendment to claim 11 is supported in the specification at, for example, page 6, lines 6-10. New claim 13 is supported by original claim 1, as well as in the specification at, for example, page 6, lines 6-10, page 7, lines 7-9, and page 8, line 18, to page 9, line 12. New claim 14 is supported by original claim 11, as well as in the specification at, for example, page 6, lines 6-10. This amendment adds no new matter.

#### Rejection under 35 U.S.C. §112, ¶2

The Office action rejects claims 1-5 and 11 as allegedly being indefinite (Office action at page 2). Without prejudice and to advance prosecution, Applicants have amended claim 1 to address the Office action's comments.

In particular, applicants have amended claim 1 to specify that the hybridization probe "comprises a DNA capable of specifically hybridizing to a target nucleotide sequence, and an additional nucleotide sequence comprising one or more nucleotides selected from the group consisting of labeled nucleotides, labeled nucleotide derivatives, unlabeled nucleotides, and unlabeled nucleotide derivatives". A similar amendment has been made to claim 11 for the same reason. Several other minor amendments have been made to claims 1, 3, 5, and 11 to ensure internal consistency with these above amendments.

Applicants consider amended claims 1, claims 2-5 that depend from it, claim 11, and new claims 13 and 14 to be clear and definite. Accordingly, applicants respectfully request that this ground for rejection be withdrawn.

#### Rejection under 35 U.S.C. §102(b)

The Office action rejects claim 1 as allegedly anticipated by a 1995 Stratagene catalogue (Office action at page 3).

The Office action states that "Stratagene discloses random primers (probes) that are 9 nucleotides in length. Such a disclosure is considered to meet a limitation of claim 1" (Office action at page 3). The test for anticipation is identity; to anticipate, a single prior art reference must disclose each and every element claimed, either explicitly or inherently (MPEP 2131). In original and amended form claim 1 contains an element specifying nucleotides or nucleotide derivatives "having weaker affinity of hydrogen bonding in base pairing with bases of the target nucleotide sequence when compared with that/those of hydrogen bonding in an a/t pair, in an a/u pair, and in a g/c pair". There is absolutely no hint of nucleotides or nucleotide derivatives with such specific characteristic in the Stratagene catalogue. The primers described in the Stratagene catalogue are designed for binding to a complementary sequence with normal affinity, forming normal a/t and g/c base pairs. In fact, one of ordinary skill in the art would expect, and even rely on, the kit shown in the Stratagene catalogue to employ nucleotides that bind their complements with normal affinity. Because it lacks at least one element recited in claim 1 (that is, "weaker affinity of hydrogen bonding") the Stratagene catalogue cannot anticipate claim 1.

The Office action rejects claims 1-5 and 11 as allegedly anticipated by Japanese Patent No. 62-244398 A (Office action at page 3).

The Office action states that JP 62-244398 A "discloses the use of probes that comprise inosine residues and that some embodiments have labeled inosinic acid residues" (Office action at page 3). As pointed out above, the test for anticipation is identity; to anticipate, a single prior art reference must disclose each and every element claimed, either explicitly or inherently (MPEP 2131). The probe disclosed in JP 62-244398 A "[consists] of polyinosine, polydeoxyinosine, oligoinosine and/or oligodeoxyinosine" and a label, but does not contain DNA sequence (that is, sequence made up of A, T, G, and C nucleotides). By contrast, amended claim 1 comprises both (1) DNA nucleotide sequence and (2) "additional nucleotide sequence comprising one or more nucleotides selected from the group consisting of labeled nucleotides, labeled nucleotide derivatives, unlabeled nucleotides, and unlabeled nucleotide derivatives". Similarly, claim 11 comprises both (1) "a DNA [nucleotide sequence]" and (2) "nucleotides and/or nucleotide derivatives". Since the cited reference does not disclose or suggest at least one

element of either claim 1 or claim 11 (that is, DNA nucleotide sequence) it cannot anticipate either of these claims. Nor, logically, can it anticipate any of the claims depending from claim 1 since these claims merely add additional claim elements to the claim from which they depend.

In light of the above, applicants respectfully request the withdrawal of these grounds for rejection.

Conclusion

Applicants consider all claims currently to be in condition for allowance, which action is respectfully requested.

Enclosed is a \$410 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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